

REMARKS

Claim 199 has been amended, and new claims 246-252 have been submitted to more distinctly claim the present invention. The matter of dependent claims 200, 203, 205, 5 208, and 215 has been resubmitted within new claims 246-252. Claims 168-169, 171-172, 174-175, 177, 180, 182, 189, 201-202, 204, 206, 210-211, 221-224, 226, 232-234, 236, 239, and 241 have been slightly amended as detailed above. Applicants believe that the foregoing amendments and the 10 following comments overcome the rejections set forth in the January 9, 2003 Office Action and that the rejections should be withdrawn.

I. THE INVENTION

15 Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium may comprise one or more sensors which may be activated, for example, by touch or the turning of a page. Also, the familiar printed 20 medium may comprise at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. When a sensor is activated or a machine recognizable

feature is detected, an electronic signal is transmitted for processing. The processing, depending on the signals received, can then result in the display of programming material related to the information contained in the printed medium. Importantly, the present invention is designed to allow a user to access programming material related to the information contained in the printed medium to supplement the information provided by the printed medium.

II. THE EXAMINER'S REJECTIONS

A. 35 U.S.C. § 102(b)

The Examiner rejected claims 168 and 199 under 35 U.S.C. § 102(b) as being anticipated by Mondschein U.S. Patent No. 4,418,278 (hereinafter referred to as "Mondschein"). Initially, the Examiner summarized various embodiments of Mondschein. The Examiner focused primarily on an embodiment that includes a page having pinhole-size perforations on its surface that allow light to penetrate through the page. A user may write on the page with a pencil, which causes the perforations to become occluded with pencil lead. Light detecting sensors located at the opposite end of the optical fibers detect the occluded perforations, whereafter, information regarding the status

of each perforation is transmitted to a decoding unit representing one bit of information. The decoding unit then displays the decoded information to the user via a display unit. Specifically, the Examiner opined that

5 catalog sheet 92, indicated in FIG. 7A of Mondschein:

"may be provided with a series of entry ports 94 adjacent [to] written material generally indicated at 96. Moreover, a part number, price-quantity matrix 98 may be provided [sic] at the
10 bottom of a catalog sheet, with entry ports as illustrated ... Thus, the marking of the catalog sheet by a pencil 100 provides all of the necessary information, such that when the catalog is connected by a fiber optic cable 102 to a
15 decoding unit 104, the information encoded in the catalog sheet may be read out and displayed at 106 or provided to a modem 108 for direct transmission to a manufacturer." (January 9, 2003 Office Action Summary, pp. 3-4).

20 The Examiner asserted that "Mondschein discloses a printed catalog comprising machine recognizable feature that can be read, decoded, and displayed to a user." (January 9, 2003 Office Action Summary, p. 5).

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-198 and 200-245 under 35 U.S.C. § 103(a) as being unpatentable over Mondshein "in view of the general teachings of the prior art of record." (January 9, 2003 Office Action Summary, p. 5). Regarding claims 169-198 and 200-245, the Examiner noted that these claims differ by claiming different types of memory means, networks, displays, and human-computer interfaces. The Examiner contended that all of these elements would have been an obvious addition to the system disclosed in Mondshein. Also, the Examiner stated that Mondshein discloses a data link, and that using specific data types would be design considerations "within the skill levels and expectations of an ordinary skilled artisan." (January 9, 2003 Office Action Summary, p. 5). The Examiner further stated that interchanging various input sources and various networks with those disclosed in Mondshein would be a design consideration that was not novel.

To support the aforementioned conclusions, the Examiner cited Veeneman *et al.* U.S. Patent No. 5,774,874 (hereinafter referred to as "Veeneman"); Montanari *et al.* U.S. Patent No. 5,478,990 (hereinafter referred to as

"Montanari"); and Sangster U.S. Patent No. 4,609,358 (hereinafter referred to as "Sangster").

Regarding Veeneman, the Examiner stated that a system that includes a bar code scanner is disclosed such that the
5 bar code scanner:

"could be located in a registrant's home such that the registrant could register for items from multiple merchants via a catalogue that includes bar codes for the items. The registrant would
10 communicate to the kiosk via remote communication, such as a modem or the InterNet. The term catalog should be understood to be not limited to a physical paper catalog, but also encompasses things such as CD-ROMs, and other
15 data storage devices." (January 9, 2003 Office Action Summary, p. 6).

With respect to Montanari, the Examiner pointed to a method for tracking the production history of a particular food product. Specifically, tags encoded with tracking
20 numbers are used to track an animal's meat product throughout the growing and production process.

"As ownership and possession of an animal is transferred, the Animal Tracking Number (A-TN) is recorded on a tag, preferably in an electronic or

computer readable form, such as a bar-code or magnetic strip, and vital information ... may be added to the database record via such tag at various times in the growth of the animal, as well as in the fabrication process." (January 9, 2003 Office Action Summary, p. 7).

Regarding Sangster, the Examiner noted that the disclosure provides student stations comprising microcomputers whereon responses to situations presented on a television or videodisc player may be entered. Further, student responses cause the appropriate output to be sent to the television monitors or cause the videodisc player to access the appropriate portion of the videodisc.

C. DOUBLE PATENTING

The Examiner rejected claims 168 and 199 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 patent"). "Although the conflicting claims are not identical, they are not patentably distinct from each other because they all recited [sic] the same limitations." (January 9, 2003 Office Action Summary, p. 9).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. 35 U.S.C. § 102(b)

5 The Examiner rejected claims 168 and 199 under 35
U.S.C. § 102(b) as being anticipated by Mondshein. Claim
168 and 199 have been amended, and three new independent
claims are presented for review. Applicants respectfully
submit that claim 168 as originally written and as amended
10 is not anticipated by Mondshein. Applicants submit that
claim 168 is amended herein purely to more clearly define
the scope of the invention and not for any reasons related
to patentability.

In particular, claim 168 recites a system comprising a
15 printed matter having at least one sensor. The sensors of
the present invention are activated by mechanical stimulus
such as touch or page turning. However, no such
mechanically activated sensor is disclosed by Mondshein.
Mondshein only discloses apparatuses that are capable of
20 being activated by light. This represents a substantially
different system with substantially different goals. While
a sensor of the present invention is designed to respond to
a user's mechanical stimulus, such as touching or page
turning, Mondshein is designed to detect occluded

perforations or the position of a pen. Thus, Mondshein does not disclose the sensor of claim 168, and therefore, cannot anticipate claim 168.

With respect to claim 199, Applicants have amended
5 this claim and present herein three new renditions of claim 199, namely claims 246, 248, and 249. Amended claim 199 and each of newly added claims 246, 248, and 249 more clearly define the machine recognizable feature as a printed machine recognizable feature, a magnetic code, a
10 bar code, and a watermark, respectively. Mondshein does not disclose the use of any of these types of machine recognizable features. In contrast, Mondshein discloses a system wherein a machine recognizes the absence or presence of light through pinhole-size perforations printed on a
15 page. In other words, if Mondshein does disclose a "machine recognizable feature," such a feature is the absence or presence of light through page perforations. Mondshein does not disclose a system wherein a machine reads a printed machine recognizable feature, a bar code, a
20 magnetic code, a watermark, or an invisible machine recognizable feature of a printed medium and accesses supplemental information related to the printed medium. Thus, Mondshein cannot anticipate claims 199, 246, 248, and 249.

Consequently, Mondshein fails to disclose any of the claimed sensors or machine recognizable features of independent claims 168, 199, 246, 248, and 249. Therefore, Applicants submit that these claims are not anticipated by Mondshein and are in condition for allowance.

B. 35 U.S.C. § 103(a)

The Examiner rejected claims 169-198 and 200-245 under 35 U.S.C. § 103(a) as being unpatentable over Mondshein "in view of the general teachings of the prior art of record." (January 9, 2003 Office Action Summary, p. 5). The matter of dependent claims 200, 203, 205, 208, and 215 has been resubmitted in new claims 246-252.

Applicants respectfully submit that none of the aforementioned claims are obvious in view of Mondshein and the general teachings of the prior art. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify Mondshein or combine it with any of the teachings of the prior art of record exists.

5 Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 15 1984) (emphasis in original).

The Examiner contended that it would be obvious to combine the teachings of Mondshein with Veeneman, Montanari, and Sangster to arrive at the various 20 embodiments of Applicants' invention. Applicants submit that none of these combinations would have been obvious to one skilled in the art at the time of Applicants' invention.

First, no suggestion or motivation exists for adding 25 the bar code scanning capabilities disclosed in Veeneman to Mondshein. Mondshein provides a page containing embedded fiber optics that sense the status of page perforations (i.e., occluded or penetrated by light) to detect the presence of handwritten lead or a location on a page. In 30 stark contrast, bar code systems cannot be used to detect

writing or a location on a page. A bar code scanner is used solely to decode the information contained within a bar code, and such information is not changed when a user writes on or otherwise chooses a location on the page on which the bar code is printed. Whereas a motivation may exist to combine other methods of sensing writing or a location on a page with Mondschein, bar code systems cannot provide that function, and therefore, there is no motivation or suggestion to combine Veeneman or any other bar code system with Mondschein.

Similarly, no suggestion or motivation exists for combining the tracking system disclosed in Montanari with the system disclosed in Mondschein. Montanari provides a tracking system for tracking the production history of a food product using tags containing encoded tracking numbers. The system disclosed in Montanari cannot be used to detect writing or a location on a page. Rather, a scanner is used solely to decode an encoded tracking number contained on a tag. This tracking system simply identifies the status of a material item. The information, or tracking tag number, retrieved from the tag upon scanning does not change when a user writes on or otherwise chooses a location on the tag. Again, whereas a motivation may exist to combine other methods of sensing writing or a

location on a page with Mondshein, the system disclosed in Montanari cannot provide that function, and therefore, there is no motivation or suggestion to combine Montanari with Mondshein.

5 Furthermore, no suggestion or motivation exists for combining the Sangster and Mondshein references. Sangster discloses a video training system for simultaneously training multiple students who respond to training prompts by entering responses on the respective student station's
10 microcomputer. Sangster intends to allow students to interact with a training program via a computer terminal having traditional keyboard and mouse inputs. By adding the fiber optics system of Mondshein which detects handwriting or location of a pen, the overall system would
15 only be unnecessarily confused because means for input already exist. Moreover, Mondshein lacks the versatility of input of a traditional keyboard and mouse and thus provides a disincentive for combination with Sangster. Consequently, there is no motivation or suggestion to
20 combine Montanari with Mondshein.

 Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for

obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the goals of the present invention.

In addition to the lack of suggestion or motivation to combine any of the aforementioned references, there is no expectation of success for any of the aforementioned combinations. Mondschein provides a page containing embedded fiber optics that sense the status of page

perforations (i.e., occluded or penetrated by light) to detect the presence of handwritten lead or a location chosen by the user of the page. In contrast, a bar code scanning system of Veeneman detects the predefined physical characteristics of the bar codes, including the quantity of printed bars and each bar's width and distance from adjacent bars. The embedded fiber optics disclosed in Mondshein cannot sense the bar code disclosed in Veeneman and the bar code scanner of Veeneman cannot sense the status of occluded perforations or locations on a page. Thus, the sensed objects and the sensing devices of these two references cannot be successfully interchanged. Consequently, there is no reasonable expectation of success in combining the Mondshein and Veeneman references.

For similar reasons, there is no reasonable expectation of success when combining the Mondshein and Montanari references. The embedded fiber optics disclosed in Mondshein cannot sense the encoded tracking number disclosed in Montanari, and the scanning system disclosed in Montanari cannot sense the status of occluded perforations or locations on a page. Thus, the sensed objects and the sensing devices of these two references cannot be successfully interchanged. Therefore, there is

no reasonable expectation of success in combining the Mondshein and Montanari references.

Finally, the microcomputer input of Sangster cannot be successfully integrated into the system disclosed in Mondshein. In essence, the entire goal in Mondshein is to provide a system that accepts *handwritten* input in order to choose corresponding information for display to the user. Alternatively, Sangster discloses a system that accepts traditional microcomputer input (i.e., keyboard, mouse, keypad, etc.) in order to choose corresponding information for display to the user. In order to combine these references, the device of Mondshein must somehow be able to provide input to the videodisc player of Sangster. This, however, is not an easy or obvious process. One must create specialized hardware and/or software to allow these devices to communicate, which would require a significant inventive step. Thus, there is no reasonable expectation of success in combining the Mondshein and Sangster references.

In addition to the lack of suggestion or motivation to combine and the lack of expectation of success for the aforementioned combinations, these combinations also lack the disclosure of each and every element of claim 168. Mondshein has already been shown to lack the sensor

contained within a printed matter of claim 168. Applicants respectfully submit that such a sensor is also not disclosed by Veeneman, Montanari, or Sangster. Because each and every element of base claim 168 is not found in these references, dependent claims 169-198, which contain all of the limitations of base claim 168, cannot be obvious in view of any combination of these references.

Consequently, Applicants submit that claims 169-198 and 200-245 of the present invention are not obvious in view of the cited references because there is no suggestion or motivation to combine the references and any attempted combination of these references does not have a reasonable expectation of success. Furthermore, the cited references lack the disclosure of each and every element of claims 169-198.

C. DOUBLE PATENTING

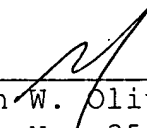
The Examiner rejected claims 168 and 199 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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